Remarks

Claims 12-23 are currently pending in the present application. No claim amendments are being made at this time. Claims 12-23 stand rejected. Each of the rejections levied in the Office Action is addressed individually below.

A telephonic interview was held on January 10, 2008 between the Examiner, Michael Bastian, and Jeffrey Buchholz. The nonstatutory obviousness-type double patenting rejection and the best method to respond to it were discussed. Both parties agreed to research the relevant issues.

Rejection under 35 U.S.C. § 102(e)

Claims 12-16, and 20-23 stand rejected as being anticipated by U.S. Patent 5,308,599 to Anseth ("Anseth"). The Examiner maintains Anseth teaches the claimed invention of claims 12-16 and 20-23. In order to remove Anseth from consideration by the Examiner, Applicant has submitted a Declaration under 37 C.F.R. 1.132 by Professor Robert S. Langer establishing that the claimed invention was not invented by another. Applicant requests that the rejection be removed since the material disclosed in Anseth was not invented by another and, therefore, Anseth is not prior art under § 102(e) to the present application.

Double Patenting

Claims 12-23 stand rejected under the doctrine of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-32 of Anseth, in view of U.S. Patent number 6,224,893 to Langer *et al*. ("Langer").

Nonstatutory obviousness-type double patenting is a judicially created doctrine grounded in public policy to prohibit the extension of patent term by preventing the issuance of a second patent which is not patentably distinct from a first patent. The inquiry in nonstatutory obviousness-type double patenting rejections is directed to "whether the claimed invention in the application for the second patent would have been obvious from the subject matter in the first patent, in light of the prior art." *In re* Longhi, 759 F.2d 887, 225 USPQ 645, 648 (Fed. Cir. 1985). An earlier granted patent with the identical filing date cannot be used as prior art in a nonstatutory obviousness-type double patenting determination during the application process of a subsequent application. *In re* Sarett, 140 USPQ 474, 477 (CCPA 1964). There, the Examiner

used the applicant's previously granted patent as the basis for a nonstatutory obviousness-type double patenting rejection despite the fact that the reference patent and the application had the same filing date and were commonly owned. The court stated that the applicant's patent disclosure, cannot be considered prior art (*Id.*).

Applicant submits that the combination of Anseth and Langer in a nonstatutory obviousness-type double patenting rejection is inappropriate based on the doctrine set forth in Longhi and Sarett. First, Anseth, has been removed from consideration by the Examiner as evidenced by the attached Declaration, as set forth above. Furthermore, the present application is a continuation of the application that resulted in the Langer patent, therefore Langer is not prior art. Both Langer and the present application have the same effective filing date. Langer cannot be used to as prior art to inform another reference regarding obviousness. Thus Langer cannot be used a prior art reference in the present rejection. Furthermore, the subject matter of the first patent, Anseth, is removed from consideration by the attached declaration, as set forth above.

Applicant thanks the Examiner for his time and consideration. If a telephone conversation would help clarify any issues or help expedite the prosecution of the case, Applicant invites the Examiner to contact the undersigned at 617-248-5222. Please charge any fees associated with this filing, or apply any credits, to our Deposit Account No. 03-1721.

Respectfully submitted,

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